

## REMARKS

Claims 11, 17-25, 43-55 and 62-71 are pending. Claim 11 has been amended to recite, *inter alia*, the genus of compounds of Formula V at page 46, lines 21-25 and page 47, lines 1-2 of U.S. Provisional Application No. 60/392,351 (“the ’351 application”), to which this application claims priority, and which is incorporated by reference on page 1 of the specification. Claims 46-47, 49-52, 54-55 and 67-71 have been canceled without prejudice. No new matter is added by the amendments.

Claims 11, 17-25, 43-55 and 62-71 stand rejected. Applicants respectfully request reconsideration of the pending rejections based on the following comments.

### **Obviousness-Type Double Patenting Rejections**

#### **A. U.S. Patent Nos. 6,812,219; 6,914,054; and 7,105,493.**

Claims 11, 17-25, 43-55 and 62-71 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent Nos. 6,812,219; 6,914,054; and 7,105,493 (“the reference patents”). Applicants respectfully disagree. However, solely to promote allowance of the application, submitted herewith are executed terminal disclaimers for filing in connection with the above-referenced application. Applicants respectfully point out that the filing of a terminal disclaimer is not an admission of the propriety of the rejection. *See Quad Environmental Technologies Corp. v. Union Sanitary District*, 949 F.2d 870 (Fed Cir. 1991); MPEP § 804.02.

##### **1. The terminal disclaimers are filed pursuant to a joint research agreement.**

The owners of the instant application are Idenix Pharmaceuticals, Inc., Università Degli Studi Di Cagliari and Centre National de la Recherche Scientifique (“the collaborative owners”). The reference patents are owned by Idenix Pharmaceuticals, Inc. and Università Degli Studi Di Cagliari. The collaborative owners have entered into a joint research agreement that, among other things, encompasses the subject matter of the instant claims and the reference patents. As will be discussed below, the reference patents are available as prior art only under 35 U.S.C. § 102(e) in the instant obviousness-type double patenting rejections. Therefore, because the reference patents are available as prior art only under 35 U.S.C. § 102(e), and the reference patents are considered owned by the same party as the instant application under 35 U.S.C. §§ 103(c)(2)(C) and (c)(3), the terminal disclaimers submitted herewith are properly filed in response to the Examiner’s obviousness-type double patenting rejections.

2. The instant claims are supported by the disclosure of the '351 application.

The reference patents are available as prior art only under 35 U.S.C. § 102(e) because each of the reference patents published later than the June 28, 2002 filing date of U.S. Provisional Application No. 60/392,351 (“the '351 application”), to which this application claims priority, and which is incorporated by reference on page 1 of the specification.<sup>1</sup> Support for instant claim 11 is found, for example, in original claims 2 and 9 and in Formula V at page 46, lines 21-25 and page 47, lines 1-2 of the '351 application, which recite compounds of Formula (II) and methods of using these compounds for the treatment of *Flaviviridae* virus infections, including the treatment of HCV infections. Because the instant claims are entitled to the priority date of the '351 application, Applicants respectfully submit that submission of the above-mentioned Terminal Disclaimers places the application in condition for allowance.

**B. U.S. Patent Application Nos. 10/602,691; 11/005,443; 11/005,446 and 11/516,928.**

The Examiner has provisionally rejected claims 11, 17-25, 43-55 and 62-71 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of co-pending U.S. Patent Application Nos. 10/602,691; 11/005,443; 11/005,446 and 11/516,928. Applicants respectfully disagree. However, solely to promote allowance of the application, submitted herewith are executed Terminal Disclaimers over U.S. Patent Application Nos. 10/602,691; 11/005,443; 11/005,446 and 11/516,928. Applicants respectfully point out that the filing of a terminal disclaimer is not an admission of the propriety of the rejection. MPEP § 804.02. Applicants respectfully submit that submission of the above-mentioned Terminal Disclaimers places the application in condition for allowance.

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<sup>1</sup> U.S. Patent Nos. 6,812,219, 6,914,054 and 7,105,493, published on March 27, 2003, March 13, 2003 and May 27, 2005, respectively. Each of these dates is later than the filing date of the '351 application (June 28, 2002).

**CONCLUSION**

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The fee for an extension of time of three months will be paid concurrently with this submission via EFS Web. The Commissioner is authorized to charge any other fees, or any credits, to Jones Day Deposit Account No. 503013 (ref. no. 417451-999016).

If the Examiner believes it would be useful to advance prosecution, the Examiner is invited to telephone the undersigned at (858) 314-1200.

Date:

1/8/09

Respectfully submitted,



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